REMARKS

Claims 1-19 remain under active prosecution in the present application. Applicants respectfully assert that all amendments are supported by the original disclosure and do not introduce new matter. Moreover, Applicants further respectfully assert that the amendments merely clarify the scope of the claims.

Claim Objections

The Examiner objected to Claims 7, 11, 14 and 19 for informalities relating to missing or inappropriate words. Appropriate correction of these claims has been made in this Response and Amendment.

Claim Rejections – 35 USC § 112

Claim 5 has been amended to clarify that the frictionally biased firing mechanism of Claim 5 is adapted to disengage the firing member when the firing control is moved in the return direction. In his Office Action of September 7, 2004, the Examiner rejected Claim 5 as vague, indefinite and confusing. Applicants believe that, as amended, Claim 5 clearly and distinctly claims the structural requirement of the firing mechanism adapted to disengage the firing member when the firing control moves in the return direction.

Claim 8 has been amended to clarify that the firing mechanism of Claim 8 includes a biasing surface, and that the biasing surface engages a friction surface of the firing mechanism in response to movement of the firing control in the firing direction. The Examiner rejected Claim 8 as vague, indefinite and confusing. Applicants believe that, as amended, Claim 8 clearly and distinctly points out the structural limitations being claimed.

The Examiner rejected Claim 10 because it was not clear what structural limitation is being claimed. Applicants respectfully assert that Claim 10, as amended, clearly claims the surgical instrument of Claim 9, wherein one of the group consisting of (i) said friction surface; and (ii) said biasing surface is deformable. Claim 11 has been similarly amended to avoid any confusion in pointing out the claimed structural limitation.

Claim 15 has been amended to clarify that Applicants are claiming the surgical instrument of Claim 8, wherein the biasing surface is a wheel. Applicants believe this amendment overcomes the Examiner's rejection of Claim 15 as unclear.

Claim 16 has been amended to more clearly claim that the frictionally biased pawl is adapted to couple the firing control to the rack in response to movement of the firing control in the firing direction, and further that the pawl is adapted to disengage the firing control from the rack in response to movement of the firing control in the return direction. The Examiner rejected Claim 16 as confusing. Applicants believe Claim 16, as amended, clearly and distinctly points out the claimed structural limitations.

Claim Rejections – 35 U.S.C. § 102(b)

Claims 1-10, 12-13 and 15:

The Examiner rejected Claims 1-10, 12-13 and 15 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,465,895 (Knodel *et al*). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. MPEP 2131; *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (Fed. Cir. 1987).

In stating his position that Knodel anticipates every element of Claim 1, the Examiner states that Knodel discloses "a firing mechanism coupled with the firing member." Office Action at p. 3. However, Claim 1 requires a firing mechanism frictionally biased to couple with the firing member when the firing control moves in the firing direction. Because the Examiner does not indicate where Knodel teaches a frictionally biased firing mechanism, a valid basis for an anticipation rejection has not been made.

Applicants respectfully maintain that Knodel does not teach a frictionally biased firing mechanism that is adapted to couple with the firing member when the firing control moves in the firing direction. To the contrary, the firing mechanism of Knodel (gear 170a, member 180 and gear 170b) is *permanently* coupled to the firing member by engagement of gear 170a with drive member 164, as shown in Figures 10 and 12 of Knodel, both in the resting position and during actuation of the firing control. Further, the firing mechanism of Knodel engages the firing member by *meshing* engagement, and is not frictionally biased to engage the firing member.

Accordingly, Applicants believe that Claim 1 is not anticipated by Knodel, and that it is in condition for allowance. Because Claims 2-10, 12-13 and 15 depend from Claim 1, these claims are also in condition for allowance.

Claim 19:

The Examiner also rejected Claim 19 as anticipated by Knodel. Claim 19 requires a firing means for frictionally coupling the firing motion of the firing actuator to the end effector. Similar to the argument above in reference to Claim 1, Knodel does not teach a firing means for *frictionally* communicating motion from the firing actuator to the end effector. Instead, Knodel teaches a system for communicating motion of the firing actuator to the end effector through *meshing* engagement of a gear 170b and a toothed rack 182 of drive member 180, as well meshing engagement of gear 170a with toothed rack 164d of drive member 164. Likewise, firing actuator 140 of Knodel meshingly engages rack 184 of drive member 180 in order to communicate motion of the firing actuator to the end effector.

Because Knodel teaches communication of motion from the firing actuator to the end effector only by meshing engagement of the firing control with the firing mechanism, and meshing engagement of the firing mechanism with the firing member, it does not disclose a "firing means for *frictionally* coupling the firing motion of the firing actuator to the end effector," as required by Claim 19. Therefore, Applicants respectfully assert that the Examiner has not stated a valid case for anticipation, and that Claim 19 is in condition for allowance.

Claims 16-19:

The Examiner rejected Claims 16-19 as anticipated by U.S. Patent No. 5,762,256 (Mastri *et al*). As amended, Claim 16 requires "a firing mechanism including a frictionally biased pawl adapted to couple the firing control to the rack to impart the firing motion in response to movement of the firing control in the firing direction, wherein further said pawl is adapted to disengage the firing control from the rack in response to movement of the firing control in the return direction." As stated above, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. MPEP 2131.

Applicants respectfully assert that the pawl taught by Mastri is not frictionally biased. Instead, the pawl of Mastri is attached to the firing actuator by a pivot pin 46, as shown in Figure 6 of Mastri. The pawl is spring-loaded so that it is oriented in the proper direction to engage the rack 42 of the firing member. When the firing actuator is moved in the firing direction, the pawl is rotated into communication with the rack 42.

Because the pawl of Mastri is not frictionally biased to communicate motion of the firing actuator to the firing member, but is instead attached by a pivot pin to the end of the firing actuator, and thereby rotates in response to actuation thereof, it does not teach the "frictionally biased pawl" limitation of Claim 16. Accordingly, Mastri does not anticipate Claim 16. Applicants therefore respectfully assert that Claim 16 is in condition for allowance. Because Claims 17-18 depend from Claim 16, they are also in condition for allowance.

The Examiner also rejected Claim 19 as anticipated by Mastri. Claim 19 requires a firing means for frictionally coupling the firing motion of the firing actuator to the end effector. However, Mastri does not disclose a means of frictionally communicating the firing motion of the firing actuator to the end effector. Instead, Mastri discloses a system in which firing motion is communicated to the end effector by rotation of a pawl that is pinned to the firing actuator. Firing motion of the firing actuator causes the pawl to rotate, engaging a rack 42 of the firing member and pushing it distally as the firing actuator is moved in the firing direction.

Because Mastri does not disclose a means for frictionally coupling the firing motion of the actuator to the end effector, it does not anticipate Claim 19. Therefore, Applicants respectfully assert that Claim 19 is in condition for allowance.

Conclusion

In light of the amendments and remarks made herein, it is respectfully submitted that the claims currently pending in the present application are in form for allowance. Accordingly, reconsideration of those claims, as amended herein, is earnestly solicited. Applicants encourage the Examiner to contact their representative, David Franklin at (513) 651-6856 or dfranklin@fbtlaw.com.

The Commissioner for Patents is hereby authorized to charge any deficiency or credit any overpayment of fees to Frost Brown Todd LLC Deposit Account No. 06-2226.

Respectfully submitted,

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I hereby certify that a copy of this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 7, 2004.

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